

REMARKS

This amendment is offered in reply to the office action of May 4, 2004.

In paragraphs 2-3 of the office action, claim 23 is rejected under 35 USC 112 as lacking antecedent basis for "the additional gasket layer". Applicant has amended claim 23 in a manner believed to overcome the Section 112 rejection.

Reconsideration of the Section 112 rejection of claim 23 is requested.

In paragraph 5 of the office action, claims 19 and 22-23 are rejected under 35 USC 102(a) in view of admitted prior art (AAPA).

This rejection is in error and is believed to be based on a misunderstanding of the AAPA on the examiner's part. In particular, only the production of gasket plate 132 shown in Figure 2 is described on page 1 of the specification as being known in the art. The examiner will note that on page 9 of the specification, Figure 2 is described as illustrating the consecutive machining steps in a conventional follow-on combination tool further described on page 12, fourth full paragraph to page 14, first full paragraph. The examiner will note that the gasket plate 132 is described on page 14, fourth full paragraph of the specification as having a rounded, corner-free outer contour.

Thus, only the device to produce gasket plate 132 using machining steps shown in Figure 2 is admitted to be known in the art on pages 1 and 2 of the specification.

The AAPA does not admit that the steps of Figure 3 employed to produce gasket plate 144 having corner 146 are known in the art. The examiner will note that Figure 2 does not illustrate the combination of steps of Figure 3 employed to produce

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gasket plate 144 having a corner 146 shown in detail in the enlarged area I comprising Figure 5.

The specification is clear that the machining steps of Figure 3 and the gasket plate 144 of Figure 4 produced thereby as well as the combination of the gasket plate 144 with corner-free gasket plate 132 as illustrated in Figures 5-6 are not known in the art.

Reconsideration of the Section 102(a) rejection of claims 19 and 22-23 in view of the AAPA is thus requested.

In paragraph 6 of the office action, claim 19 is rejected under 35 USC 102(b) as anticipated by US Patent 5 582 415.

Pending claim 19 recites a gasket comprising at least a first metal gasket plate and a second metal gasket plate disposed one on the other to form a multi-plate gasket wherein the first metal gasket plate and the second gasket plate have the features recited and not disclosed in the '514 patent.

The '514 patent merely discloses a cylinder head gasket comprising a beaded metal gasket plate having one or more coating layers pattern printed on sides thereof. For example, Figure 5 of the patent shows a coating layer (30, 31) on the sides of beaded gasket plate 11, while Figure 7 shows multiple coating layers (30, 31, 34). The coating layers can be selected from synthetic rubbers, plastics, or composite materials. The coating layers do not include cut edges.

The '514 patent does not disclose Applicant's multi-plate gasket having first and second metal gasket plates disposed one on the other wherein a) an outer contour of a cut edge of the first metal gasket plate comprises a free-cutting line and an outer contour line and wherein the free-cutting and outer contour lines together form a corner and b) wherein a cut edge of

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the second metal gasket plate projects beyond the corner on the first metal gasket plate when the first metal gasket plate and the second metal gasket plate are disposed one on the other in the multi-plate gasket.

The '514 patent simply does not disclose a gasket having such features as are recited in pending claim 19.

Reconsideration of the Section 102(b) rejection of claim 19 is thus requested.

In paragraph 7 of the office action, claims 22-23 are rejected under 35 USC 102(b) as anticipated by US Patent 2 753 199.

Pending claim 22 recites a gasket comprising at least a first metal gasket plate and a second metal gasket plate disposed one on the other to form a multi-plate gasket wherein the first metal gasket plate and the second gasket plate have the features recited.

In contrast to pending claim 22, the '199 patent discloses a cylinder head gasket comprising a single sheet metal body 1 having sides coated with a thermosetting resinous coating 5 having inorganic filler material stuck thereto. The thermosetting resinous coating 5 can be an alkyd resin. The coatings 5 do not include cut edges.

The '199 patent does not disclose Applicant's multi-plate gasket comprising at least a first metal gasket plate and a second metal gasket plate disposed one on the other to form a multi-plate gasket, wherein an outer contour of a cut edge of the first gasket plate comprises a free-cutting line and an outer contour line, the free-cutting and outer contour lines together forming a corner, and wherein a cut edge of the second gasket plate comprises a first outer contour line section following a course of the outer contour line of the first gasket

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plate or a course of the free-cutting line of the first gasket plate when the first gasket plate and the second gasket plate are disposed one on the other in the multi-plate gasket, and a second outer contour line section smoothly adjoining the first outer contour line section of the second gasket plate in the area of the corner of the first gasket plate when the first gasket plate and the second gasket plate are disposed one on the other in the multi-plate gasket.

The '199 patent simply does not disclose a gasket having features as are recited in pending claims 22-23.

Reconsideration of the Section 102(b) rejection of claims 22-23 is thus requested.

In paragraph 9 of the office action, claims 9, 11-19, and 22-25 are rejected under 35 USC 103(a) in view of admitted prior art (AAPA) taken with DE 884936 ('936).

This rejection is believed to be in error. Firstly, as discussed above, the examiner is believed to have misunderstood the AAPA. In particular, only the production of gasket plate 132 shown in Figure 2 is described as being known in the art.

The AAPA does not admit that the combination of process steps set forth in claims 9, 11-18 and 24-25 are known. In fact, the AAPA is utterly deficient in disclosing or suggesting the combination of steps of these claims.

Secondly, Applicant disagrees with the proposed combination of the '936 reference with the AAPA. In particular, the '936 reference involves a process for the manufacture of furniture fitting members. The manufacture of furniture fitting members is not believed to be even remotely pertinent to manufacture of Applicant's gaskets and not properly combinable therewith as proposed by the examiner. The proposed combination of the '936

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reference with the AAPA appears to constitute a prohibited hindsight analysis of Applicant's claims.

Thirdly, the '936 reference does not make up for the deficiencies of the AAPA noted by the examiner. In particular, the '936 reference involves a process for the manufacture of furniture fitting members wherein the fitting members are punched out of a metal sheet by means of punching tools (e.g. f and g) having corners to their cutting edges as can be seen from Figure 1 of the reference and from the enclosed attachment A showing the '936 reference cutting tool.

Further, the outer contour line cut by the tool (e.g. m) for cutting out a contour line according to the '936 reference does not dip into the cutting areas (first cutting area and second cutting area) cut by the punching tools in the preceding punching stations, but only meet the second cutting area at a corner thereof (see the attachment A of the '936 reference cutting tool).

The '936 reference teaches only to use punching tools having corners to their cutting edges and to use a tool for cutting an outer contour line which does not dip into the free-cutting area, but only meets the free-cutting area at a corner thereof. The '936 reference as well as the AAPA teach away from the subject matter of Applicant's pending claims 9, 11-18, and 24-25.

With respect to claims 19 and 22-23, these claims are believed patentable over the AAPA taken with the '936 reference for the reasons set forth above and also since the '936 reference involves manufacture of furniture fitting members, which are not pertinent to and utterly unrelated to Applicant's claimed gasket structure.

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Reconsideration of the Section 103(a) rejection of claims 9, 11-19, and 22-25 is requested.

In paragraph 10 of the office action, claim 18 is rejected under 35 USC 103(a) in view of admitted prior art (AAPA) taken with the '936 reference and an additional reference selected from either US 4 862 574; US 3 998 300; or US 3 822 461.

Applicant believes the rejection of claim 18 is incorrect. As discussed above, the examiner is believed to have misunderstood the AAPA. In particular, only the production of gasket plate 132 shown in Figure 2 is described as being known in the art. In fact, the AAPA is utterly deficient in disclosing or suggesting claim 18.

The proposed combination of the '936 reference with the AAPA is believed incorrect and not to suggest Applicant's claim 18 for the reasons set forth above.

Moreover, Applicant believes the rejection clearly constitutes a hindsight analysis of claim 18 given the large number of references as well as their irrelevance as pointed out in Applicant's previous response, which is incorporated herein by reference for convenience.

Reconsideration of the Section 103(a) rejection of claim 18 is requested.

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Applicant believes the pending claims are in condition for allowance, and action to that end is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Edward J. Timmer', with a stylized flourish at the end.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service under 37 CFR 1.8 as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 4, 2004.

A handwritten signature in black ink, appearing to read 'Edward J. Timmer', with a stylized flourish at the end.

Edward J. Timmer